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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,686	09/04/2001	Martha Torrey O' Connor	05222.00157	2969

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BANNER & WITCOFF AND ATTORNEYS FOR ACCENTURE
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EXAMINER

CHRISTMAN, KATHLEEN M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/868,686		O' CONNOR ET AL.	
	Examiner		Art Unit	
	Kathleen M Christman		3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/30/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/30/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In response to the amendment filed 11/30/2004 claims 1-18 and newly added claims 19-30 are pending.

Claim Rejections - 35 USC §101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

1. Claims 1-9 and 19-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

Technological Arts Analysis:

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-9 and 19-24 recite an abstract idea. The recited steps of merely presenting information, determining a personality, integrating information, and monitoring progress and providing feedback so as to advance a student towards reaching a goal does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

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As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

Useful, Concrete and Tangible Analysis:

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

In the present case, the claims produce a useful, concrete and tangible result. The final result of the method is providing feedback. The feature is useful in that the feedback can be used to continue the learning process, concrete in that it can be reproduced (i.e. the method always results in this step) and tangible in that feedback is a real item.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-30 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/44766, to Agent Based Curricula, INC., herein after the '766 publication. The '766 publication teaches a method and system for the presentation of educational content including the steps of and logic for: presenting a pre-test that includes at least one question regarding a personality profile (student model data) of a student before generating the presentation; determining the personality profile of the student from at least one answer in response to the at least one question; configuring the presentation based on the personality

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profile of the student before generating the presentation (page 105: 6-35, where initialization is discussed); integrating information in the presentation that motivates accomplishment of a training goal tailored to the personality profile of the student (page 100: 1-20); monitoring the progress toward the training goal and providing feedback that further motivates accomplishment of the training goal tailored to the personality profile of the student (page 100: 24-30), as in **claims 1 and 10**. The personality profile of the student includes a learning need of the student (**claims 2 and 11**), as is shown in the description of the standards and objective on page 100, line 27. Providing praise to the student if the personality profile of the student is indicative of praise (**claims 3 and 12**) is shown on page 23, lines 24-26. Having a student repeat an exercise if the personality profile of the student is indicative of problems (**claims 4 and 13**) is shown on page 20, line 11. Utilizing a selected portion of the personality profile of the student to feed back work of the student to the student (**claims 5 and 14**) is shown in Figure 4. Regarding **claims 6 and 15**, the step of determining the personality profile by performed by comparing answers to pre-stored answers indicative of known personality profiles in the inherently functionality of the above mentioned tests. Feedback being presented based upon a number of times the personality profile of the student matches a particular personality profile (**claims 7 and 16**) is shown on page 57 lines 5-10. The profile of the student being determined based upon interaction with an agent (**claims 8 and 17**) is shown in Figure 1, element 118 and discussed throughout the specification. The environment is described as a corporate simulation, which is by definition a business scenario, as in **claims 9 and 18**, see page 14, lines 28-35. Configuring a navigation interface to indicate a training need of the student (**claims 19 and 25**) is shown in section 5.6.2, which begins on page 106. Regarding **claims 20-22 and 26-28**, the features of determining a student's proficiency alter the presentation either by providing additional tasks (remediation) or removing tasks are shown on page 20, lines 7-14. Storing performance data regarding the student actions and feedback presented to the student (**claims 23 and 29**) and analyzing this data (**claims 24 and 30**) is shown on page 101 line 33 – page 102 line 9.

Response to Arguments

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3. The previous rejection of claims 10-18 under 35 USC §101 has been withdrawn in view of the amendments made in the response. Claims 1-9 now produce a useful, concrete and tangible result, but remain rejected under 35 USC §101 for lack of a technological feature, as explained in the rejection above. The previous rejections under 35 USC §112, second paragraph are withdrawn in view of the amendments to the claims.

The previous rejection of the claims under 35 USC §102(e) as being anticipated by Cook et al (US 5727950) has been withdrawn in view of the amendments to the claims. Specifically the addition of the limitations reciting a "pre-test" has forced the withdrawal of this reference as an anticipatory reference.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kathleen M. Christman
April 7, 2005



XUAN M. THAI
SUPERVISORY PATENT EXAMINER

AU 3713